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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,649	09/14/2000	Zaid Jayyosi	02481.1690	1144

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EXAMINER

PATEL, SUDHAKER B

ART UNIT	PAPER NUMBER
1624	19

DATE MAILED: 01/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
**09/662,649**

Applicant(s)

**Zaid Jayyosi et al**

Examiner  
**SUDHAKER PATEL,D.Sc.Tech.**

Art Unit  
**1624**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Nov 7, 2002

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1, 2, 8, 15, 29-31, 53, 55-59, 61-66, 91, 92, and 96-104 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1, 2, 8, 15, 29-31, 53, 91, 92, and 97-102 is/are rejected.

7)  Claim(s) 55-59, 61-66, 96, 103, and 104 is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

Applicants' communication paper # 18 dated 11/7/02 is acknowledged.

The claims in this application are the claims 1,2,8,15,29-31,53,55-59,61-66,91-92, 96-104.

After further review and consideration, this application is found not suitable for allowance as is for the reasons stated bellow.

**I. Restriction/Election:** restriction/election has already been made FINAL as per Office Action Paper # 17 dated 8/7/02.

Applicants' request to modify restriction/election has been considered but not found persuasive for the new rejections stated bellow.

Examiner has tried to expand search further wherein Ar I as heteroaryl (optionally substituted) and is a bicyclic(6 member-6 member) ring; a=1; b =1, and an art was found. As per the guidelines stated in earlier Office Action paper #17 cited above, the examination was limited to the compounds of formula as shown in claim 1 wherein a/b = 1; Ar I = Heteroaryl only. Other definitions of AR I i.e. bicyclic rings( 6-member-5-member)fused arylheterocylenyl, fused arylheterocyclyl, fusedheteroarylcycloalkenyl, fused heteroarylcycloalkyl, fused heteroarylheterocyclenyl, or fused heteroarylheterocyclyl and also all other definitions of the other variables from the generic claims are held withdrawn from consideration. Claim 8 wherein a and b = 0; claim 97, and claims 98-101 dependent on this claim wherein a = 1, b = 0 are additionally

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withdrawn from consideration under 37 CFR 1.142(b). as being drawn to non-elected subject matter.

Therefore, search has been limited , and the variables are:

**Ar I** = heterocycle optionally substituted and is a bicyclic(6 member-6 member) ring

**Ar II** = phenyl, optionally substituted;

**A** = -O-(R15 R16)<sub>g</sub>-O-; g = 1-5;

**B & E** = Chemical bond;

**Z** = non-heterocycle;

c and d = zero;

a and b = 1;

R1-R4 = H/halogen/alkyl.

**II.**

***Claim Rejections - 35 U.S.C. § 112***

Claim rejection under 35 U.S.C. 112 paragraph one have been made moot as claim 54 has been canceled.

**III.**

***Claim Rejections - 35 U.S.C. § 102***

**IIIA.** Applicants arguments for rejections(Howkins et al) under 35 U.S.C. 102(e) have been considered and found persuasive for withdrawal of the same.

**IIIB. New Rejections:** ***Claim Rejections - 35 U.S.C. § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,8,15,29-31,53,91,92,102(readable on genus of elected invention and species wherein a=1; b =1) are rejected under 35 U.S.C. 102(b) as being anticipated by Kahovcova et al(Chemical Abstr. 111:115036; also cited as CS 248922 dated 3/12/1987).See the compounds encompassed by the generic formula of abstract and compound having CAS RN # 122156-11-0 (= Butanedioic acid, 1-(2,2-dimethyl-2H-1-benzopyran-6-yl)propyl 1-(4-((5-(3,3-dimethloxiranyl))-3-methylpentyl)oxy)phenyl)propyl ester) which forms the core: " Optionally substituted Heteroaryl-substituted alkylene-O-(R15R16)g-O-substituted alkylene-Optionally substituted phenyl-Z.

Claims 1,2,8,15,29-31,53,91,92,102(readable on genus of elected invention and species wherein a=1; b =1) are rejected under 35 U.S.C. 102(b) as being anticipated by Kozikowski et al(Chem. Abstr. 110:56678; also cited as Tetrahedron Lett.,28/43,5125-28(1987). See the compounds encompassed by the CAS RN # 118617-88-2 (=1H-Indole,4-(((4-methoxyphenyl)methoxy)methoxy)methyl)-1-((4-methylphenyl)sulfonyl)-.

**IV.**

***Claim Objections***

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Applicants' amendment(s) to claim 30 are sufficient to withdraw the objections and the same have been now withdrawn.

**V. New Rejections:**      *Claim Rejections - 35 U.S.C. § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 and dependent claims 2, 30 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

1. Evidence that claims 2, 3 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the specification. On page 5 applicants define Ar I as heteroaryl, and on page 12, lines 15-32, "heteroaryl" could be aza-heteroaryl in which at least one of the carbon atoms in the ring system is replaced by a heteroatom, i.e. other than carbon which is only consisting of one Nitrogen . The term azaheteroaryl has not been defined exactly in claim 1, and heteroaryl optionally substituted has not been exactly defined in claim 1 to take care of claim 30. The term heteroaryl is not clearly defined in claim 1., and the use of " at least one.." as defined in specification is indefinite because we are not exactly told about the make up of the heterocycle with other atoms. See Petrolite Corp. V.s. Watson, Comr. Pats., 113 USPQ 248.

It is not exactly clear as to what applicants want to present in claim 1. Although applicants have not presented the term "at least one" in claim 1 the definition of heteroaryl in specification does recite the same. Therefore, it is confusing to read and to interpret claim 1 very clearly.

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2. Claim 1 defines the substituents R1-R4, R21, R15, R16 as "Alkyl". This is indefinite because it is not exactly defined and is not acceptable. See *In re Lund et al.*, 153 USPQ 625.
3. Claim 1 recites in definition of substituents R21, R15, R16 the term "aralkyl" which is indefinite. See *In re Lund et al.*, 153 USPQ 625.
4. Claim 1 recites in the definition of substituent R21, the term "aryl" which is indefinite. See *In re Sus et al.*, 135 USPQ 301; *In re Lund et al.*, 153 USPQ 625.
5. Claim 1 recites R21 as: "substituted aryl" which is indefinite. See *In re Sus et al.*, 134 USPQ 301.
6. Claim 1 defines AR II = Optionally substituted phenyl. At the same time in the Formula(I) of claim 1 when c/d = zero, , and B & E = a chemical bond, Z variant becomes a substituent on to the ARII which is phenyl optionally substituted with one or more "ring system substituents" (see specification page 9 lines 10-13. On page 15 lines 25-35 and on page 16 lines 1-2, applicants define "Ring System substituents" as alkoxy, alkoxycarbonyl, cyano, acyl,  $R_c R_d NCO = NH_2 CO -$  . Therefore, it is very confusing to read and interpret the definition of Z variable on to phenyl and the "optionally substituted phenyl" which are overlapping. It is not very clear as to what applicants want to present in claim 1.

**VI.**

***Allowable Subject Matter***

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Claims 55-59,61-66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 96,103 and 104 are also objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker Patel, D.Sc.Tech. whose telephone number is (703) 308 4709.

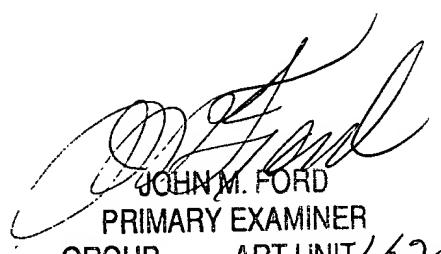
The examiner can normally be reached on Monday thru' Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Dr.Mukund Shah can be reached at (703) 308 4716 or Sr. Examiner Mr. Richard Raymond at (703) 308 4523.

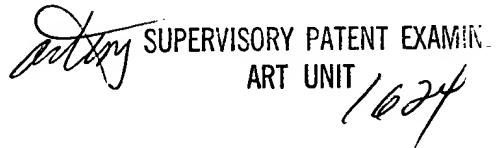
A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

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Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308 1235.

SP/ 16 January, 2003.

  
JOHN M. FORD  
PRIMARY EXAMINER  
GROUP - ART UNIT 1624

  
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ART UNIT 1624